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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/039,728	10/19/2001	Gordon Timothy Burstein	43197.240364	2255
826	7590	10/01/2004	EXAMINER	
ALSTON & BIRD LLP BANK OF AMERICA PLAZA 101 SOUTH TRYON STREET, SUITE 4000 CHARLOTTE, NC 28280-4000			PHASGE, ARUN S	
		ART UNIT	PAPER NUMBER	
		1753		

DATE MAILED: 10/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/039,728	BURSTEIN ET AL.
	Examiner	Art Unit
	Arun S. Phasge	1753

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 09 February 2004.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) 14 is/are allowed.
- 6) Claim(s) 1, 2, 7, 9-13, 15-17 is/are rejected.
- 7) Claim(s) 3-6, 8 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2/9/04, 2/12/04</u> | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 7, 12, 13, 15-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Gilroy.

Gilroy discloses the claimed method of treating a steel article by electrolysis in the presence of an electrolyte, selected from the group claimed, using alternating pulses of at least one of voltage and current, said alternating pulses being of opposite polarity (see claims 1-3 and table on page 5). The reference further discloses the treatment of steel or titanium (see claim 7). The electrolyte is aqueous (see claim 3). The limitation to a particular type of steel would be included in the generic description of Gilroy's steel, since the generic description of steel would include all the species of this well-defined and specified group. The waveform would be sinusoidal or square if they are reversing.

Claims 1, 2, 7, 12, 13, 15-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Sone Yuji, Japanese Patent JP62158898.

Sone Yuji discloses the claimed method of treating a steel article by electrolysis in the presence of an electrolyte, selected from the group claimed, using alternating pulses of at least one of voltage and current, said alternating pulses being of opposite polarity (see abstract). The reference further discloses the treatment of steel or titanium (see abstract). The electrolyte is aqueous (see abstract). The limitation to a particular type of steel would be included in the generic description of Gilroy's steel, since the generic description of steel would include all the species of this well-defined and specified group.

Claims 1, 2, 7, 12, 13, 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Ishida Shinichi, Japanese Patent JP60128288.

Ishida Shinichi discloses the claimed method of treating a metal article by electrolysis in the presence of an electrolyte, selected from the group claimed, using alternating pulses of at least one of voltage and current, said alternating pulses being of opposite polarity (see abstract). The electrolyte is aqueous (see abstract). The limitation to a particular type of steel would be included in the

generic description of Gilroy's steel, since the generic description of steel would include all the species of this well-defined and specified group.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gilroy.

The Gilroy patent does not disclose the use of the treated steel or titanium article, or the use of the electrolysis conducted insitu. It would have been obvious

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to one having ordinary skill in the art at the time the invention was made to modify the disclosure of the Gilroy patent, because such intended use of the article following treatment provides little or no patentable weight to the method claims and the Gilroy patent teaches that the electrolysis treatment provides protection against corrosion (see page 2). Further the site of the electrolytic treatment provides little or no patentable weight to the process of treating the metal.

Response to Arguments

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arun S. Phasge whose telephone number is (571) 272-1345. The examiner can normally be reached on MONDAY-THURSDAY, 7:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nam X Nguyen can be reached on (571) 272-1342. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Arun S. Phasge
Primary Examiner
Art Unit 1753

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